

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed May 25, 2004. Claims 1-35 are pending in the present application. The Examiner rejects Claims 1-35.

Claim Objections

The Examiner rejects Claim 11 because the word "wherein" is repeated twice in two places in the claim. Applicants have amended Claim 11 to address the issue noted by the Examiner. Therefore, reconsideration and favorable action are requested.

Section 103 Rejections

The Examiner rejects Claims 1-3, 5-7, 10-15, 17-20, 23, 25-27, 30-32, and 34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,958,010 issued to Agarwal ("*Agarwal*") in view of U.S. Patent No. 6,321,338 issued to Porras ("*Porras*"). The Examiner also rejects Claims 4, 16, and 33 under 35 U.S.C. § 103(a) as being unpatentable over *Agarwal* in view of *Porras* and further in view of U.S. Patent No. 6,510,350 issued to Steen ("*Steen*"). Finally, the Examiner rejects Claims 8-9, 21-22, 24, 28-29, and 35 under 35 U.S.C. § 103(a) as being unpatentable over *Agarwal* in view of *Porras* and further in view of U.S. Patent No. 5,826,239 issued to Du ("*Du*").

In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations. M.P.E.P. § 2143. In the present case, a *prima facie* case of obviousness cannot be maintained for at least two reasons. First, neither *Agarwal* nor *Porras* provides a suggestion or motivation to combine the references. Second, even assuming for the sake of argument that the references did suggest or motivate a combination of the references to a person of ordinary skill in the art at the time of the invention, *Agarwal* and *Porras*, whether considered singly, in combination with one another, or in combination with information generally available to those of ordinary skill in the art at the time of the invention, still fail to disclose all of the elements of the pending claims.

A. No Motivation or Suggestion to Combine *Agarwal* and *Porras*

The M.P.E.P. sets forth a strict legal standard for finding obviousness based on a combination of references. According to the M.P.E.P., “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. 2143.01. The “fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination.” *Id.* (emphasis in original).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

¹ Note M.P.E.P. 2145(X)(C) (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).²

In the present case, the Examiner is improperly using the Applicant's disclosure as a blueprint for piecing together various elements of Agarwal and Porras. For example, the Examiner merely asserts that it would have been obvious "incorporate the network surveillance of Porras with the network monitoring system of Agarwal because it would provide for the purpose of protecting the networks components from intrusion and global attacks." Office Action, page 4. However, Applicants respectfully submit that this statement does not identify a suggestion in the references to combine the references. As described above, simply because references can be combined in an advantageous way does not mean that there is a suggestion or motivation to combine the references. The mere assertion that the teachings of one reference might improve the teachings of another reference, as the Examiner states, does not provide the required suggestion to combine. In this case, the Examiner has only described that it could be advantageous to combine Agarwal and Porras, but has not identified a location in the references or elsewhere in the art that suggest the desirability of making the combination.

Consequently, a *prima facie* case of obviousness cannot be maintained with respect to Claims 1-35, as the Examiner has not shown the requisite proof necessary to establish a suggestion or motivation to combine the cited references. For at least this reason, Applicants respectfully request reconsideration and allowance of Claims 1-35.

B. The Cited References Fail to Disclose, Teach, or Suggest Each and Every Element of the Claims

Even assuming for the sake of argument that the cited references did suggest or motivate a combination of the references to a person of ordinary skill in the art at the time of the invention, *Agarwal* and *Porras*, whether considered singly, in combination with one another, or in combination with the other cited references or information generally available to those of ordinary skill in the art at the time of the invention, would still fail to disclose each and every element of the claims of the present Application.

² See also *In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.).

1. The References Fail to Disclose All the Elements of Claims 1, 12, 31, 32 and 33

Independent Claim 1, as amended, recites the following limitations:

A system for enabling remote monitoring and management of one or more applications within a domain, the domain being one of a plurality of such domains, the system comprising:

one or more computers within the domain and coupled to a network, each operable to execute one or more applications being monitored and managed;

a firewall operable to limit access to the applications within the domain from the network;

an application management layer within the domain comprising:

one or more agents each operable to monitor one or more corresponding applications and generate notifications in response to the occurrence of events associated with the corresponding applications; and

a gateway operable to receive one or more of the notifications and store the notifications in a database; and

a communication layer within the domain operable to:

retrieve one or more of the notifications from the database in response to a request received from a monitoring and management portal coupled to the network outside of the domain, the request communicated to the communication layer using a communication protocol providing access through the firewall; and

communicate the notifications to the monitoring and management portal using the communication protocol to enable remote monitoring and management of the associated applications.

Independent Claims 12, 31, 32 and 33 recite similar, although not identical, limitations.

As recognized by the Examiner, *Agarwal* fails to disclose storing notifications that are generated in response to the occurrence of events associated with applications in a database. Instead, the Examiner states that *Porras* discloses this limitation. However, *Porras* does not disclose the missing elements. First, *Porras* simply discloses monitoring packets communicated via a network entity (such as a firewall) in a domain. It does not disclose monitoring *events associated with applications* and thus also does not disclose that notifications generated in response to these events are stored in a database. Furthermore, even assuming for the purposes of argument that *Porras* does disclose generating the recited notifications, it does not disclose storing the notifications in a database. For the teaching of this limitation, the Examiner points to Column 14, lines 51-53 of *Porras*. However, this passage simply discloses a “mass storage device” that stores the “instructions” (software) used to implement the

disclosed packet monitors themselves, not to store any alleged notifications generated by the monitors for later retrieval.

Furthermore, *Agarwal* and *Porras* fail to disclose retrieving one or more of the notifications from the database in response to a request received from a monitoring and management portal coupled to the network *outside of the domain*, the request communicated to the communication layer using a communication protocol providing access *through the firewall*. The Examiner argues that *Agarwal* discloses receiving a request from a monitoring and management portal and retrieving one or more of the notifications from the database in response to the request. The Examiner recognizes that *Agarwal* does not disclose that the request is communicated through a firewall (and similarly *Agarwal* does not disclose that the monitoring and management portal is coupled to the network *outside of the domain*). The Examiner indicates that *Porras*' disclosure of a firewall in a domain provides the missing teachings. However, the mere fact that *Porras* discloses a firewall and a monitor does not mean that the combination of the two references discloses receiving a request for a notification from a monitoring and management portal *outside of the domain* and the firewall (even assuming for the purposes of argument that *Agarwal* does teach receiving a request for a notification from a monitoring and management portal inside the domain). Applicants respectfully submit that the Examiner is improperly piecing together the references.

For these reasons, Applicants respectfully request reconsideration and allowance of Claims 1, 12, 31, 32 and 33, as well as Claims 2-11 and 13-23, which depend from Claims 1 and 12, respectively.

2. The References Fail to Disclose All the Elements of Claims 11, 24, and 35

Dependent Claim 11, as amended, recites the following limitations:

The system of Claim 1, wherein:
the communication layer is further operable to:
 receive a command for a particular application communicated from the monitoring and management portal using a communication protocol providing access through the firewall associated with each selected domain; and
 communicate the command to an agent associated with the application to which the command is directed; and
the agent is further operable to execute the command using a monitor within the agent associated with the application to which the command is directed and corresponding to the particular application, the monitor operable to interface with the particular corresponding application.

Independent Claims 24 and 35 recite similar, although not identical, limitations.

Agarwal and *Porras* fail to disclose communicating a command for a particular application received from a monitoring and management portal to an agent associated with the application to which the command is directed. In the rejection of Claim 11 and the rejection of Claims 24 and 35, respectively, the Examiner cites two different passages of *Agarwal* that purportedly disclose this limitation (see Office Action, page 5, citing col. 7, lines 60-64; and Office Action, page 12, citing col. 5, lines 15-34, respectively). However, neither of these passages relates in any way to this limitation and Applicants are unclear how the Examiner is reading the passages to disclose this limitation. Neither passage discloses sending a command for an application to an agent associated with that application and neither passage discloses receiving any sort of communication from a monitoring and management portal.

Furthermore, *Agarwal* and *Porras* fail to disclose that an agent is operable to execute the command using a monitor within the agent that is associated with the application to which the command is directed. Again, in the rejections of Claim 11 and Claims 24 and 35, respectively, the Examiner cites two different passages of *Agarwal* purportedly disclosing this limitation (see Office Action, page 5, citing col. 7, lines 11-29; and Office Action, page 12, citing col. 7, lines 6-13, respectively). However, neither of these passages recites an agent executing a command associated with an application. At best, these passages disclose sending commands to an agent relating to notifications to be sent from the agent. Applicants respectfully submit that this does

not disclose, teach, or suggest executing a command that is *associated with and directed to an application*.

For these reasons, Applicants respectfully request reconsideration and allowance of Claims 11, 24 and 35, as well as Claims 25-30, which depend from Claim 24.

3. The References Fail to Disclose All the Elements of Claim 34

Independent Claim 34, as amended, recites the following limitations:

A method for remotely monitoring electronic marketplace enabling applications across a plurality of distributed domains, comprising:

detecting the occurrence of events associated with a plurality of electronic marketplace enabling applications executed on a plurality of computers within a plurality of domains, each domain coupled to a network and including a firewall limiting access to the applications within the domain;

generating notifications in response to the occurrence of the events, each notification associated with at least one application;

storing at least some of the notifications in databases within the domains that comprise the associated applications;

retrieving notifications from the databases of a plurality of selected domains in response to a request received from a monitoring portal coupled to the network outside the domain, the request communicated to the selected domains using hypertext transport protocol (HTTP);

generating a response at each domain including the retrieved notifications for the domain that may be interpreted by a web browser within the monitoring portal;

communicating the response from each of the selected domains to the web browser through the firewall using HTTP; and

making the retrieved notifications from each of the selected domains available at a computer associated with the monitoring portal for display to a user of the monitoring portal in a unified view in which the notifications are aggregated.

Claim 34 contains similar limitations to the limitations discussed above with respect to Claims 1, 12, 31, 32 and 33 and should be allowable for the reasons discussed above with respect to those claims. Furthermore, Claim 34 recites making the retrieved notifications from each of the selected domains available at a computer associated with the monitoring portal for display to a user of the monitoring portal in a *unified view in which the notifications are aggregated*. *Agarwal* and *Porras* fail to disclose to the this limitation, specifically displaying notifications from each of the selected domains in a unified view. Furthermore, the Office

Action does not appear to address this claim limitation. Therefore, Applicants respectfully request reconsideration and allowance of Claim 34.

CONCLUSION

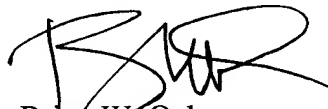
Applicants have made an earnest attempt to place this application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

Applicants believe no fees are due; however, the Commissioner is hereby authorized to charge any fee and credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

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